

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB JULY  
16, 97

Hearing:  
November 14, 1996

Paper No. 19  
EJS

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

---

Trademark Trial and Appeal Board

---

In re Faultless Starch/Bon Ami Company

---

Serial No. 74/331,559

---

J. David Wharton of Shook, Hardy & Bacon for Faultless  
Starch/Bon Ami Company

Steven R. Fine, Trademark Examining Attorney, Law Office 107  
(Thomas Lamone, Managing Attorney)

---

Before Cissel, Seeherman and Hairston, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Faultless Starch/Bon Ami Company seeks registration on  
the Supplemental Register for GARDEN CLAW as a trademark for  
"hand-operated garden tools, namely cultivator-weeders."<sup>1</sup>

---

<sup>1</sup> Application Serial No. 74/331,559. This application was  
originally filed, on November 16, 1992, seeking registration on  
the Principal Register, based on an asserted bona fide intention  
to use the mark in commerce. Initially, the Examining Attorney  
required a disclaimer, which applicant provided. Registration  
was subsequently refused pursuant to Section 2(e)(1) of the  
Trademark Act, and when this refusal was made final, applicant  
filed an amendment alleging use as of August 31, 1992, and on

Registration has been refused by the Trademark Examining Attorney pursuant to Section 23 of the Trademark Act, 15 U.S.C. 1091, on the ground that GARDEN CLAW is incapable of identifying applicant's goods and distinguishing them from those of others.

Both applicant and the Examining Attorney have filed briefs on the case, and both appeared at an oral hearing before the Board.<sup>2</sup>

It is the Examining Attorney's position that GARDEN CLAW is incapable of distinguishing applicant's garden tools because it is a generic term for such goods. In support of this position, he has relied on a definition of "claw" in Webster's Third New International Dictionary, unabridged, © 1976--"a gardening tool for loosening soil" and the following excerpts of articles taken from the NEXIS database:<sup>3</sup>

---

January 12, 1994 filed an amendment to seek registration on the Supplemental Register.

<sup>2</sup> With his brief the Examining Attorney submitted an excerpt of an article taken from the NEXIS database, explaining that the article had not previously been made of record because it appeared after the issuance of the Office action finally refusing registration on the Supplemental Register. In such circumstances, the better practice is for the Examining Attorney to request that the application be remanded in order to make such material of record. See Trademark Rule 2.142(d). However, at the oral hearing on this case, applicant stated that it had no objection to the Board's consideration of this article, and therefore we deem the article to have been stipulated into the record.

<sup>3</sup> The Examining Attorney had, during the examination of this application, also made of record excerpts from two articles which referred to companies which sold a tool called the Garden Claw. Applicant explained that these companies were related to

...When plants are quite dead and you are ready to pull out potatoes, it is wise to go about the task rather carefully, using such hand tools as claws or trowels rather than garden forks or spades...

"The Washington Post," July 30, 1987

"HOME IMPROVEMENT GUIDE Be sure to dig up the right tools before going to your garden (headline)

..."Claw for cultivating tight areas...."

"The Atlanta Journal and Constitution," Sept. 17, 1992

...trained pigs or dogs sniff them out and paw at the ground where they are located. A harvester comes after the animals with a garden claw and digs up the truffles....

"Austin American-Statesman, " July 13, 1995

'Twin Peaks': Splash on Both Sides of Atlantic; Who Killed Laura Palmer? Stay Tuned! (headline)

...Is the show's second Laura Palmer diary--the one being hidden by Harold, the shut-in who raises orchids, gets meals on wheels and scratches divots in his face with a garden claw--really a copy of the Laura Palmer diary written by David Lynch's daughter....

"The New York Times," Nov. 8, 1990

Good Deed Etched in Cemetery (headline)  
...a second, smaller group labored amid the toppled headstones with hoes and rakes and garden claws, clearing away the brush and trash....

"Chicago Tribune," Oct. 14, 1985

The Examining Attorney has also pointed to a registration owned by O. M. Scott & Sons, which includes in

---

applicant, and that the articles referred applicant's own use of GARDEN CLAW as a trademark. The Examining Attorney has not

its identification of hand tools, namely lawn and garden implements, "claws." The Examining Attorney asserts that this identification by a company which sells lawn and garden tools shows that "claw" is understood by the trade as the name of a garden tool.

To counter this evidence, applicant has submitted definitions of "claw" taken from five dictionaries, including the unabridged Random House Dictionary of the English Language,<sup>4</sup> Webster's New World Dictionary,<sup>5</sup> Webster's II New Riverside University Dictionary,<sup>6</sup> and The American Heritage Dictionary.<sup>7</sup> These dictionaries all bear copyright dates subsequent to the 1976 date of the Webster's dictionary on which the Examining Attorney relies. None of these dictionaries defines "claw" as a gardening tool. As a result, applicant asserts that the definition cited by the Examining Attorney must be considered to be obscure.

Moreover, applicant has submitted the affidavit of D. Kevin Houlihan, the Group Merchandising Manager for Cotter & Co., the largest member-owned wholesale distributor of hardware and related products in the world. Mr. Houlihan stated that for nine years he has been involved with the marketing of lawn and garden products, and that "the name

---

referred to these articles in his brief.

<sup>4</sup> 2d ed., © 1987.

<sup>5</sup> 2d coll. ed., © 1984.

<sup>6</sup> © 1988.

<sup>7</sup> 2d coll. ed., © 1985.

Garden Claw is associated exclusively with [applicant's] product"; that "there is no other tool or implement to which the name GARDEN CLAW is applied which is marketed in the United States"; and that "the name Garden Claw is not now and to my knowledge never has been generic for any type of tool or implement which has ever been marketed in the United States."

A term which is generic is not capable of distinguishing one party's goods from those of another, and therefore is not registrable on the Supplemental Register. The burden of showing that a proposed trademark is generic is on the Patent and Trademark Office, and must be made by a substantial showing by the Examining Attorney of genericness, based on clear evidence of generic use. **In re Merrill Lynch, Pierce, Fenner, and Smith Inc.**, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). Moreover, the critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question. **H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.**, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). Thus, we must determine whether the primary meaning of GARDEN CLAW to those who would use or purchase hand-held cultivator-weeders, e.g., those who do gardening, is that of a name of a cultivator-weeder.

Applicant points out that the two articles referring to "garden claw" which were of record at the time it filed its brief dealt with a television show and the good deed involved in cleaning up a cemetery. We agree with applicant that these articles, as well as the article about gathering truffles submitted with the Examining Attorney's brief, do not show that those who garden, the relevant purchasers of the goods, would view GARDEN CLAW as a generic term for a cultivator-weeder.

We recognize that the Examining Attorney has also submitted a dictionary definition, two articles which are directed to gardening activities, and a registration, all of which use "claw" as a generic term for a gardening tool. The Examining Attorney himself recognizes that this evidence is limited:

The term GARDEN CLAW is not widely used, nor is the term CLAW as such widely used, to designate a variety of garden tool That is the conclusion from reviewing the available LEXIS/NEXIS evidence. ...

The evidence of record is not, to be sure, overwhelming. And one may choose to regard it as merely insufficient. ...  
Final Office action, mailed March 17, 1995.

However, the Examining Attorney relies heavily on the Webster's unabridged dictionary definition, essentially asking how it can be ignored.

The dictionary definition cited by the Examining Attorney certainly shows that at the time the dictionary was published in 1976 the editors considered "claw" to mean a kind of gardening tool. We are, however, troubled by the fact that only the Webster's unabridged dictionary ascribes such a meaning to the term, while five other dictionaries, including the Random House unabridged, and two other Webster's dictionaries, do not. Particularly troubling is the fact that these other dictionaries were published subsequent to the Webster's unabridged.

Moreover, if "claw" were perceived by the relevant public as the generic term for a gardening tool in 1976, at the time the Webster's unabridged dictionary was published, we find it somewhat odd that the Examining Attorney was unable to submit any generic usages in newspaper articles or catalogs from that time and that, in the twenty years since that publication, the Examining Attorney has uncovered only two articles about gardening, from 1987 and 1992, in which "claw" was used, and one registration in which the registrant identified its gardening tool as a "claw" at the time the underlying application was filed in October 1992. If such tools were available in 1976, to the extent that they were referenced in a dictionary definition at that time, one would assume that, if the relevant public recognized this meaning, there would be more references to

"claw" in the subsequent 20-year period than just the two articles and the one registration that the Examining Attorney has made of record. See **In re Volvo White Truck Corp.**, 16 USPQ2d 1417 (TTAB 1990).

Concomitant with the dearth of evidence of generic usage of "claw" for a hand-operated weeder-cultivator is the affidavit of one in the trade, knowledgeable about gardening tools, who has testified that GARDEN CLAW is not and has never been a generic term for any type of tool or instrument.

On this record,<sup>8</sup> we are compelled to agree with applicant that the Examining Attorney has not established that "claw," and consequently "garden claw,"<sup>9</sup> would be recognized by the relevant public as the generic term for hand-operated cultivator-weeders. In view thereof, we find that the Patent and Trademark Office has not met its burden

---

<sup>8</sup> We wish to make it clear that our decision herein rests, as it must, on the record presented by the Examining Attorney and applicant. A different result might obtain if evidence of competitors' usages were to be submitted in the context of an inter partes proceeding.

<sup>9</sup> Applicant has argued that even if the Examining Attorney's evidence showed that "claw" is a generic term, it would be insufficient to prove that "garden claw" is generic. However, the Examining Attorney has shown that gardening tools are referred to generically by using "garden" as a prefix, e.g., garden rake, garden spade. Thus, if "claw" were, in fact, shown to be generic for a weeder-cultivator, the addition of "garden" would not prevent the compound term GARDEN CLAW from being found generic. See **In re Gould Paper Corp.**, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) (genericness may be shown by evidence that the separate words joined to form a compound have a meaning identical to the meaning common usage would ascribe to those words as a compound).



**Ser No.** 74/331,559

of making a substantial showing by clear evidence that GARDEN CLAW is incapable of distinguishing applicant's goods from those of others.

Decision: The refusal of registration is reversed.

R. F. Cissel

E. J. Seeherman

P. T. Hairston  
Administrative Trademark Judges  
Trademark Trial and Appeal Board